

Status of Claims

Claims 1-20 were pending. After entry of the above amendments, claims 1-35 are pending. Claims 1, 6, 8, and 16 were amended for refinement. Claims 5 and 13 were amended merely to correct a few typographically incorrect mid-sentence periods into commas. Claims 5 and 13 were amended without changing claim scope whatsoever, and should even more be interpreted exactly as if they had been originally presented in the as-amended form. New claims 21-35 claim the invention more extensively without adding new matter.

Item 1 of the Office Action quotes 35 U.S.C. §102(b) (hereinafter, "Section 102(b)").

Item 2 rejects claims 1-4, 9-11, and 16-19 under Section 102(b) as being anticipated by Brennan et al. (U.S. Pat. No. 5,329,578), hereinafter, "Brennan".

Item 3 quotes 35 U.S.C. § 103(a) (hereinafter, "Section 103(a)").

Item 4 rejects claims 5, 6, 8, 12-15, and 20 under Section 103(a) as being unpatentable over Brennan.

Item 5 rejects claim 7 under Section 103(a) as being unpatentable over Brennan in view of Will (U.S. Patent 5,905,789).

Items 6 and 7 give contact information for the Examiner and the Examiner's supervisor.

The Rejections Under Section 102(b)

Claims 1-4, 9-11, and 16-19 stand rejected under Section 102(b) as being anticipated by Brennan.

Claim 1

Claim 1 recites the following features that were present before the amending of claim 1:

1. (Amended) A method for enabling a caller to locate a called party using a computer system comprising:  
providing a contact list manager (10) in which a called party can store a list (22) of two or more contacts; and

*upon receiving a request to locate a called party, referring to said contact list to automatically attempt to locate said called party ...*

The Office Action reads claim 1's "contact list manager" onto Brennan's system that uses Table 4.0 (Brennan, col. 7). Claim 1, as amended, further recites the following limitations:

*... wherein said automatically attempt to locate said called party comprises:*

*automatically sending a message via a first contact method, said first contact method associated with a contact in said contact list, said message requesting location information regarding said called party;*

*receiving a response to said message, said response indicating a second contact method, other than said first contact method, for attempting to reach said called party; and*

*automatically processing the response to facilitate use of said second contact method to attempt to reach said called party*

The above limitations are not anywhere taught or suggested in Brennan. On the contrary, Brennan states:

*The caller will normally have available four single-digit DTMF commands. These can, for example, be:*

*enter password (e.g. the numeral 4 key to prefix the password); operator assistance request (zero key);*

*skip over welcome message (#key);*

*skip directly to messaging (numeral 6 key); and*

*login - subscriber's calling (key)*

*Additionally, callers may be requested to make a Call Completion [i.e., Brennan's Table 4.0] or Call Urgency determination via DTMF signals.*

(Brennan, col. 11, lines 13-23; bracketed text added)

Brennan's Table 4.0, cited in the Office Action and referenced in the above-quoted passage of Brennan, teaches merely an example of handling a telephone call by taking a "MESSAGE", transferring the call to an "OPERATOR", or transferring the call to a "PAGER".

Thus, it is seen that Brennan handles calls either by recording a message from the caller ("MESSAGE") or by transferring the call to another number. Ultimately, either the called party is reached or not reached at a forwarding

number, or an operator/secretary ("OPERATOR") takes care of the call without further automatic assistance or processing. In short, under Brennan's system, there is not any teaching of claim 1's features of "requesting location information regarding said called party", "receiving a response ... indicating a second contact method, other than said first contact method, for attempting to reach said called party", and "automatically processing the response to facilitate use of said second contact method to attempt to reach said called party". It is seen that Brennan's approach is

From the above discussion, it is seen that Brennan does not teach or suggest all of claim 1's features, and Brennan in fact teaches an entirely different approach from that taken by claim 1. Accordingly, Applicants respectfully submit that claim 1, as amended, is not anticipated by Brennan and is allowable over Brennan.

### Claim 16

For convenience, Claim 16 is reproduced:

16. (Amended) *An apparatus for automatically locating a called party comprising:*

*a contact list manager (10) in which a called party can store a list (22) of two or more contacts;*

*a configuration interface (18);*

*a locator (60) capable of sending out location request messages and receiving and handling responses, wherein a response, to a location request message sent to a first destination (22a), indicates a second destination which is to be subsequently called to reach the called party, and said first and second destinations are of different multimedia types.*

Claim 16, as amended, includes limitations similar to those discussed above in connection with claim 1. Accordingly, claim 16 is patentable for similar reasons as is claim 1.

In addition, claim 16, as amended, recites a limitation that "said first and second destinations are of different multimedia types". Brennan does not anywhere teach or suggest such a limitation. On the contrary, Brennan teaches only communication with telephone, telephone pager, and telephone voicemail devices and does not anywhere teach or suggest receiving a second destination

for reaching the called party that is of any different multimedia type from the first destination. For this additional reason, Applicants respectfully submit that claim 16, as amended, is not anticipated by, and is patentable over, Brennan.

#### Dependent Claims

Dependent claims 2-4, 9-11, and 17-19 include all limitations of their respective base claims and are allowable for at least the same reasons as their respective base claims. The assertions and rejections from the Office Action regarding the dependent claims 2-4, 9-11, and 17-19 are therefore rendered moot.

#### The Rejections Under Section 103(a)

Claims 5, 6, 8, 12-15, and 20 stand rejected under Section 103(a) as being unpatentable over Brennan. Claim 7 stands rejected under Section 103(a) as being unpatentable over Brennan in view of Will.

#### Claim 6

For convenience, claim 6 as amended is reproduced:

6. *(Amended) A method for a locating a called party comprising: receiving a request to locate a called party; automatically sending messages to multiple parties listed in a contact list requesting location information regarding said called party; and canceling outstanding messages when a response is received to said messages.*

Claim 6, as amended, recites the limitation of "automatically sending messages to multiple parties listed in a contact list requesting location information regarding said called party; and canceling outstanding messages when a response is received to said messages". The Office Action conceded, in connection with claim 5, that Brennan "fail[s] to teach canceling outstanding messages when a response is received". Applicants respectfully agree.

However, the Office Action contended that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to cancel

outstanding contact messages once the party of interest has been located".

Applicants respectfully disagree. Brennan teaches:

*Another feature disclosed with the present invention is the Hunting feature. There are times when the subscriber may be moving fairly often between a fixed set of locations (e.g. a construction manager who is away from his desk on and off all day, and carries a portable cellular phone with him when he is away). Hunting allows contact to be made with subscribers without the subscribers having to constantly update their locations manually. This feature allows the subscriber to list up to three locations by which the system is to attempt to contact him. The system will normally "hunt" to the next location if the subscriber doesn't answer, or a call to a shared telephone is answered and it is indicated that the subscriber is not there. The system is designed to stop hunting to the next location in the list if a location is busy.*

(Brennan, col. 10, lines 7-22, underlining added)

As can be seen, Brennan's system performs purely linear "hunting". Each possible location is tried, and only when there is no answer ("doesn't answer") or if the called party is "indicated ... [as] not there", does the system proceed to try the next possible location. Under Brennan's scheme, there are simply no such outstanding messages that need to be canceled. Thus, it would be nonsensical to cancel any such message when there is nothing to cancel. Thus, there is no suggestion or motivation to cancel any such outstanding message and no expectation of success for somehow canceling any such outstanding message.

For the just-discussed reason, Applicants respectfully submit that claim 6, as amended, is patentable over Brennan.

#### Dependent Claims

Dependent claims 5, 7, 8, 12-15, and 20 include all limitations of their respective base claims and are allowable for at least the same reasons as their respective base claims, and for the additional limitations that they recite. Dependent claims 5, 7, 8, 12-15, and 20 recite, or include via dependency, limitations involving "canceling" or the like that are at least similar to the limitation discussed above in connection with claim 6. Therefore, dependent claims 5, 7,

13-15, and 20 are seen to be allowable (further) for at least the same reasons as is claim 6.

The New Claims

New claims 21-35 claim the invention more extensively without adding new matter. They are distinguished from the cited art for reasons similar to those discussed above. New claims 21-35 recite additional limitations that are not taught or suggested by the cited art. Merely to point out some examples, claim 23 recites "automatically extracting said second contact method", claim 24 recites "using speech recognition software", claim 25 recites "using optical recognition software", claim 26 recites "recording said second contact method and playing the response for said caller", and claim 34 recites "wherein said messages include a number or address at which said calling party may be reached by said parties listed in said contact list, and an instruction for said parties to directly contact said calling party via said number or address".

CONCLUSION

Therefore, Applicants submit that their invention is not disclosed, taught, or suggested by the references of record. Therefore, it is submitted that all of the claims are allowable over the art of record and it is respectfully requested that the application be passed to allowance.

Respectfully submitted,

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VII. Version of Amendments with Markings to Show Changes Made

1. (Amended) A method for enabling a caller to locate a called party using a computer system comprising:

providing a contact list manager (10) in which a called party can store a list (22) of two or more contacts; and

upon receiving a request to locate a called party, referring to said contact list to automatically attempt to locate said called party, wherein said automatically attempt to locate said-called party comprises:

automatically sending a message via a first contact method, said first contact method associated with a contact in said contact list, said message requesting location information regarding said called party;

receiving a response to said message, said response indicating a second contact method, other than said first contact method, for attempting to reach said called party; and

automatically processing the response to facilitate use of said second contact method to attempt to reach said called party.

5. (Amended) A method according to claim 2 wherein said automatically attempting to locate said called party comprises:

automatically sending one or more messages to parties listed in a contact list requesting location information regarding said called party[.]

receiving responses to said one or more messages and presenting a response to a calling party; and

canceling outstanding messages when a response is received.

6. (Amended) A method for locating a called party comprising:

receiving a request to locate a called party; [and]

automatically sending [**one or more**] messages to multiple parties listed in a contact list requesting location information regarding said called party; and

canceling outstanding messages when a response is received to said messages.

8. (Amended) The method according to claim 6 further comprising [:  
**receiving responses to said one or more messages and]** presenting a response to a calling party[; and  
**canceling outstanding messages when a response is received].**

13. (Amended) A method according to claim 12 wherein:  
the calling party is automatically notified of said responses[.],  
said responses contain a contact method for reaching the called party[.],  
the called party may cancel the called party location process at any time including automatically canceling, expiring and/or recalling all dispatched messages.

16. (Amended) An apparatus for automatically locating a called party comprising:  
a contact list manager (10) in which a called party can store a list (22) of two or more contacts;  
a configuration interface (18);  
a locator (60) capable of sending out location request messages and receiving and handling responses, wherein a response, to a location request message sent to a first destination (22a), indicates a second destination which is to be subsequently called to reach the called party, and said first and second destinations are of different multimedia types.